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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,738	06/07/2001	Toyoaki Kishimoto	450100-03276	9194
20999	7590	11/03/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			PHAN, TAM T	
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			2144	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

03

Office Action Summary	Application No. 09/876,738	Applicant(s) KISHIMOTO, TOYOAKI	
	Examiner Tam (Jenny) Phan	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been examined. Claims 1-19 are presented for examination.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
3. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 15-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter of a "program per se". Programs per se are not patentable.
6. For examining purposes, "an information-processing program" and "an information provide program" in claims 15-19 will read as "an information-processing program encoded on a computer readable medium" "an information providing program encoded on a computer readable medium" to allow these claims to be examined with respect to the prior art.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/862,656. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the two pending applications are minor wording, which do not change the scope of the invention. Refer to the below observation for obvious variations of limitation in claims 1-19 of the instant application and claims 1-23 of the pending application.

9. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Instant 09/876,738	Pending Application 09/862,656
<p>1. An information-processing apparatus comprising: storage means for storing application programs and data files; processing means for activating an application program stored in said storage means to carry out required processing; communication means for communicating data with an external server; and control means for controlling said communication means and said storage means; wherein said control means controls said communication means and said storage means in such a manner that when an application program is downloaded from said server connected by said communication means, if</p>	<p>1. An information-processing apparatus comprising: storage means for storing application programs and data files; calculating means for activating an application program stored in said storage means to carry out predetermined processing; media drive means for recording and playing back information into and from an external recording medium; and control means which controls said media-drive means and said storage means when said external recording medium for recording an application program is mounted on said media drive means so that: when said storage means includes a remaining free storage area with a</p>

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said storage means has a free storage area left in which said application program is allowed to be installed, said application program downloaded from said server is installed in said storage means; but if said storage means has no free storage area left in which said application program is allowed to be installed, an application program or a data file stored in said storage means is saved to an external recording medium by way of said communication means in order to allocate a free storage area in said storage means and then said application program transmitted from said server is installed in said storage means.

2. The information-processing apparatus according to claim 1, further comprising: activation-history management means for storing information on an activation history for each application program and for updating said information on an activation history for a specific application program upon activation of said specific application program by said processing means; wherein said control means selects an application program to be saved to said external recording medium on the basis of said information on an activation history.

3. The information-processing apparatus according to claim 1, wherein said storage means is a non-volatile storage area.

4. The information-processing apparatus according to claim 1, wherein if an application program or a data file saved in said external recording medium exists at completion of use of an active application program downloaded from said server, said control means controls operations carried out by said communication means and said storage means to delete said active application program from said storage

size large enough for accommodating said application program recorded in said external recording medium, said application program recorded in said external recording medium is installed in said storage means; but when said storage means includes a remaining free storage area with a size not large enough for accommodating said application program recorded in said external recording medium, on the other hand, an application program or a data file stored in said storage means is saved to said external recording medium in order to allocate a free storage area in said storage means and then said application program recorded in said external recording medium is installed in said storage means.

2. An information-processing apparatus according to claim 1, wherein said information-processing apparatus further has an activation-history management means for storing activation history information for each application program on said storage means and for updating said activation history information for a specific application program upon activation of said specific application program by said calculating means, and said control means selects an application program to be saved to said external recording medium on the basis of said activation history information.

3. An information-processing apparatus according to claim 1 wherein said storage means is a non-volatile storage area.

4. An information-processing apparatus according to claim 1 wherein, when an application program or a data file has been saved in said external recording medium being dismounted from said media drive means, said control means controls said media-drive means and said storage means to uninstall an application program installed from said external recording medium into said storage

means in order to restore said saved application program or saved said data file from said external recording medium to said storage means by way of said communication means.	means in order to restore said installed application program to said external recording medium and to restore said application program or said data file saved in said external recording medium to said storage means.
5. The information-processing apparatus according to claim 1, wherein said processing means activates an application program upon installation of said application program downloaded from said server into said storage means.	5. An information-processing apparatus according to claim 1 wherein said calculating means activates an application program upon installation of said application program from said external recording medium into said storage means.
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.	.
.	.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent Number 6,360,364), hereinafter after referred to as Chen in view of Kanevsky et al. (U.S. Patent Number 6,393,470), hereinafter referred to as Kanevsky.

12. Chen disclosed an information-processing apparatus comprising: storage means for storing application programs and data files (Abstract, Figure 6 sign 252); processing means for activating an application program stored in said storage means to carry out required processing; communication means for communicating data with an external server (Figure 5 signs 242, 244, column 3 lines 40-52, column 5 lines 33-50, column 6 lines 36-48); and control means for

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controlling said communication means and said storage means (column 5 lines 13-19, column 8 lines 45-53); wherein said control means controls said communication means and said storage means in such a manner that when an application program is downloaded from said server connected by said communication means, if said storage means has a free storage area left in which said application program is allowed to be installed, said application program downloaded from said server is installed in said storage means (Abstract, Figures 6 and 7); but if said storage means has no free storage area left in which said application program is allowed to be installed, the information processing apparatus will determine whether expansion storage means are available and if yes, then said application program transmitted from said server is install in said storage means (Abstract, Figures 6 and 7).

13. Chen taught the invention substantially as claimed. However, Chen did not expressly teach that if said storage means has no free storage area left in which said application program is allowed to be installed, *an application program or a data file stored in said storage means is saved to an external recording medium by way of said communication means in order to allocate a free storage area in said storage means* and then said application program transmitted from said server is installed in said storage means.

14. Chen suggested exploration of art and/or provided a reason to modify the information-processing apparatus with the storage allocation feature to increase resources (column 1 lines 26-35, column 2 lines 21-28, column 3 lines 17-27)

15. Kanevsky disclosed an information processing apparatus for freeing storage means in portable devices by saving an application program or a data file stored in said storage means an external recording medium [server storage] by way of said communication means in order to

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allocate a free storage area in said storage means (Title, Abstract, Figure 1, column 8 lines 13-25).

16. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the information processing apparatus of Chen with the teachings of Kanevsky to include the storage allocation of moving application programs or files to an external medium in order to facilitate the installation process since if the memory space available is insufficient to accommodate a new application program, installation will fail (Chen, column 3 lines 17-30). In situation like this, users must either delete one or more applications programs or files from the storage means to free up resources for the new application program (Chen, column 3 lines 17-30).

17. Regarding claim 2, Kanevsky disclosed an information-processing apparatus further comprising activation-history management means for storing information on an activation history for each application program and for updating said information on an activation history for a specific application program upon activation of said specific application program by said processing means (Figure 4, column 2 lines 18-38, column 6 lines 42-49); wherein said control means selects an application program to be saved to said external recording medium on the basis of said information on an activation history (Figure 3, Abstract, column 8 lines 13-25).

18. Regarding claim 3, Chen disclosed an information-processing apparatus wherein said storage means is a non-volatile storage area (column 8 lines 19-31).

19. Regarding claim 4, Chen disclosed an information-processing apparatus wherein if an application program or a data file saved in said external recording medium exists at completion of use of an active application program downloaded from said server, said control means

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controls operations carried out by said communication means and said storage means to delete said active application program from said storage means in order to restore said saved application program or saved said data file from said external recording medium to said storage means by way of said communication means (column 2 line 57-column 3 line 9, column 3 lines 17-30).

20. Regarding claim 4, Chen disclosed an information-processing apparatus wherein said processing means activates an application program upon installation of said application program downloaded from said server into said storage means (Figure 6, column 8 lines 4-11).

21. Regarding claim 6, Chen and Kanevsky disclosed a server comprising: communication means for carrying out communications of data (Chen, Abstract, Figure 5 sign 246); downloaded-data storage means for storing a variety of application programs to be downloaded (Chen, Figure 5 sign 240I); saved-data storage means (Kanevsky, Figure 1 sign 112); and control means for controlling said communication means, said downloaded-data storage means, and said saved-data storage means (Chen, Figure 5 signs 242, 244); wherein when said server receives a download request from an information processing apparatus connected to said server via said communicating means for carrying out communications of data (Chen, Figures 6-7, column 3 lines 40-52), said control means transmits an application program stored in said downloaded-data storage means to said information processing apparatus (Figures 6-7, column 3 line 64-column 4 line 16) and when said server receives a saving request from said information apparatus, said control means stores an application program or a data file transmitted from said information processing apparatus in said saved-data storage means as saved data (Kanevsky, Abstract, Figure 1).

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22. Regarding claim 7, Chen and Kanevsky combined disclosed an information processing apparatus for "on-demand" downloading and installation application programs from a remote server as well as migrating existence application programs or files to the remote server to allocate space for the new application programs (Refer to rejection above for details). Examiner takes Official Notice (see MPEP § 2144.03) that "charging means" for on-demand downloading/installing of digital contents and "charging means" for storage resources in a computer networking environment was well known in the art at the time the invention was made. Refer to PTO-892 for teachings of charging means for digital contents and storage resources.

23. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

24. Regarding claim 8, the information communication system corresponds directly to the information-processing apparatus and the server of claims 1 and 6, and thus is rejected using the same rationale.

25. Regarding claim 9, the information communication system corresponds directly to the server of claim 7, and thus is rejected using the same rationale.

26. Regarding claims 10-12, the information providing method corresponds directly to the server of claims 6-7, and thus these claims are rejected using the same rationale.

27. Regarding claims 13-14, the information providing method corresponds directly to the server of claims 6-7, and thus these claims are rejected using the same rationale.

28. Regarding claims 15-17, the information-processing program encoded on a computer readable medium corresponds directly to the information-processing apparatus of claims 1-2 and 4, and thus these claims are rejected using the same rationale.

29. Regarding claims 18-19, the information providing program encoded on a computer readable medium corresponds directly to the server of claims 6-7, and thus these claims are rejected using the same rationale.

30. Since all the limitations of the claimed invention were disclosed by the combination of Chen and Kanevsky, claims 1-19 are rejected.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Rautila (U.S. Patent Number 6,714,797) titled "System and method for the transfer of digital data to a mobile device" disclosed a system, method and computer program for ordering, paying for and download digital products to a mobile device in a cost-effective manner. The mobile device includes a short-range transceiver and a network transceiver. The mobile device accesses electronic shop server web sites which

contain digital products for sale and hotspot network locations where these digital products may be downloaded to the mobile device via the short range transceiver.

b. Henrick et al. (U.S. Patent Number 6,507,727) titled "Purchase and delivery of digital content using multiple devices and data networks" disclosed a system that facilitates the purchase and delivery of digital content over the Internet. The disclosed system allows a user who hears or sees digital contents broadcast to use a cell phone or other wireless device to order the broadcast material for a charge, and have it remotely delivered to an independent device without further user intervention. Thus, the system allows the user to order the desired content using a wireless device that the user will often have in his or her possession when he or she hears or sees the desired content, but to have the content delivered to a second remote device.

c. Tognazzini (U.S. Patent Number 6,470,396) titled "Method for continuing executing a program on a second computer after all information related to the program are being copied from a first computer" disclosed a handheld computing device is used to copy files from the screen of a fixed computer. The display of the handheld device is linked to that of the underlying computer and file and directory icons together with their underlying files are copied to the handheld device. Files from the handheld device can also be transferred to the fixed computer. When a user is running a program on the fixed computer, he may capture the state of that computer and transfer everything needed to permit execution of that program to continue uninterrupted on the handheld device. Thus files and executing programs may be lifted from the fixed computer and used on the handheld device.

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d. Yokota et al. (U.S. Patent Number 6,691,149) titled "System for distributing music data files between a server and a client and returning the music data files back to the previous locations" disclosed a data communication system for distributing music data files between a server and a client removably connected to the server. The system transfers music data files and corresponding management data from a client to a server. The server then determines whether the music data files were previously stored in the server on the basis of the corresponding management data transferred from the client and a management data file in the server. If it is determined that the music data files were previously stored in the server, the music data files transferred from the client are stored into their previous locations in the server. In this manner, the music data files may be repeatedly moved to and from the server and maintain their ordering on the server.

Refer to the enclosed PTO-892 for details and complete listing of other pertinent prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (703) 305-4665 or (571) 272-3930 (new telephone number after October 18, 2004). The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on 703-308-3873 or (571) 272-3925 (new telephone number after October 27, 2004). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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